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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,877	10/18/2001	Anthony E. Martinez	AUS920010923US1	7079
7590	03/10/2005		EXAMINER	
Frank C. Nicholas CARDINAL LAW GROUP Suite 2000 1603 Orrington Avenue Evanston, IL 60201			BONSHOCK, DENNIS G	
			ART UNIT	PAPER NUMBER
			2173	
DATE MAILED: 03/10/2005				

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/981,877

Filing Date: October 18, 2001

Appellant(s): MARTINEZ ET AL.

Frank C. Nicholas (reg. 33,983)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/29/04.

Art Unit: 2173

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-16 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Art Unit: 2173

Microsoft Corporation. "Microsoft Word 2000", Microsoft Corporation, 1999, attached screen shots: MS figure 1 trough MS figure 10

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-16 are rejected under 35 U.S.C. 102(a). This rejection is set forth in a prior Office Action, mailed on 8-26-04.

(11) *Response to Argument*

With respect to the group of claims including Claims 1-16, the Appellant's arguments are focused on the limitations regarding the "displaying a graphical image associated with the icon". More specifically, as stated from representative Claim 1, the limitation argued is:

displaying the graphical image associated with the icon in response to the icon preview instruction

Since the interpretation of the limitation is the basis for the arguments, the Examiner's interpretation is now given. The Examiner asserts the limitation 'displaying the graphical image associated with the icon' as being very broad and not explicit about the representative "image." A graphical image comprises any image displayed on a screen, whether being textual, pictorial, etc., in nature. As stated in the eighth paragraph of MPEP 2101[R2].II.C.,

"Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997)."

Based on the interpretation of the claim limitations being argued, the Examiner will now explain how the teachings of the reference Microsoft Word, hereinafter MSword, are within the scope of these limitations.

MSword teaches a system that allows a user to copy and paste items inside the document window (as displayed in MS figure 1), these items, once copied are placed on a clipboard, and upon copying of multiple items the user is supplied with a Clipboard of available items copied and ready for further action (see MS figure 2). A user can then select items to be pasted via selecting an icon, representing the copied subject matter, on the Clipboard (see MS figures 2-4). Should the user desire to see what subject matter each icon represents, the user can move their pointer over an icon, the icon then provides a graphical depiction of what copied content the icon represents (see MS figures 2 and 5). The Examiner interprets the textural description of the icons contents to be a graphical image, as any element displayed on the display is a graphical depiction of the stored subject matter. The examiner contends that when text is displayed on a display the text itself is a graphical image.

The examiner will now address the individual arguments and statements made by the Appellant.

From pages 4 and 5 of the Appeal Brief, from the second paragraph on page 4 to first paragraph continued on page 5, the Appellant argues "As the "reference" does not disclose 'displaying the graphical image associated with the icon in response to the icon preview instruction,' as claimed in claim 1," the applicant argues that at most the reference is a text sample of a clipboard icon, and not a graphical image.

The examiner contends that MSword does show a graphical image (a box surrounding the graphical image of text 'The cat ran up'), associative of an icon (the 'W' on a page), in response to an icon preview instruction (the user positioning the cursor over the icon) (see MS figure 2). The examiner further contends that the depiction is indeed a text sample, but is rendered as a graphical depiction on the display. The claims are silent to any processing that takes place prior to the graphical display of the image, and though it may be a textural description, when rendered it is a graphical image.

From pages 4 and 5 of the Appeal Brief, from the third paragraph on page 4 to first paragraph continued on page 5, the Appellant further argues that "Were the Examiner's computer using a graphical image, the fonts on the two samples, (i.e. on the screen and on the popup) would be identical."

The examiner contends that this argument by the applicant proves nothing and only shows that the text, stored in memory, has been accessed and displayed as graphical images using two different fonts.

From page 5 of the Appeal Brief, in the first full paragraph, the appellant argues that “MS figure 9 not only does not disclose the claimed elements, MS figure 9 equivocally teaches away from displaying a graphical image – “If the item is a drawing object or picture, or an item that doesn’t contain text, Microsoft Word displays a label “Picture 2,” which indicates the order in which the item was copied.” Such a statement clearly indicates not only the reference does not teach displaying “the graphical image associated with the icon,” but the statement directly teaches away from doing such an action.”

The examiner contends that the teaching of MS figure 9, shows the graphical depiction “Picture 2”, which is a graphical image (a box containing a graphical depiction of the text “Picture 2”), displayed to indicate the order in which the item was copied (therefor being representative of the contents). The examiner further contends that the depiction is indeed a textual description, but is rendered as a graphical image on the display.

From page 5 of the Appeal Brief, in the first paragraph, the appellant argues that “MS figure 9 teaches and discloses that the program can only preview “50 characters of text.”

The examiner does not see where this teaching contrasts with the teaching of the appellant. The appellant provides not explanation of why this teaching of MSword contrasts to the Applicant's invention.

From page 5 of the Appeal Brief, in the third full paragraph, the appellant argues that "The Examiners argument that "MSword" discloses a graphical image associated with an image on the clipboard is disingenuous. Claim 1 requires displaying the graphical image associated with the icon in response to the icon preview instruction and not the "image on the clipboard.""

The examiner contents that all three, the represented item, the items representation on the clipboard, and the preview of the item upon moving the cursor over the representation of the item on the clipboard, are all related. The item being copied (as shown in MS figure 1), is then stored in the clipboard (as displayed in figures 2 and 3) and upon mouse over, provides a graphical image of associated with both the icon and the original image.

From page 5 of the Appeal Brief, in the fourth full paragraph, the appellant argues that, "Applicants further note that the "reference" does not teach or suggest the desirability of using a graphical icon as a preview.

The examiner contents that the reference clearly shows that providing a graphical image associated with an icon, informs the user of what the contents of the icon is (see MS figure 2). Through this means, the user can determine which

item he or she wants to access among the plurality of items available on the Clipboard.

From page 6 of the Appeal Brief, in paragraphs 1 and 2, the appellant argues that, "MSWord is not prior art, per MPEP 2128." "First, the Examiner has not stated, nor even alleged, that the documents were ever publicly accessible, much less accessible to persons concerned with the art to which the documents relate. The Examiner admits that the documents are screen shots of the Examiner's own computer taken April 22, 2004. Thus the earliest these documents could possibly have been publicly accessible is 2.5 years after the filing of this application.

The examiner contend that to qualify as a reference under 35 U.S.C. 102 (a),
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
The MSWord reference meets this limitation, as is shown by figure 8, stating that the Copyright for the Microsoft Word 2000 program is 1983-1999. This date alone proves that the MSWord reference was known and used prior to the filing of the applicants claimed invention.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Dennis G. Bonshock
March 3, 2005

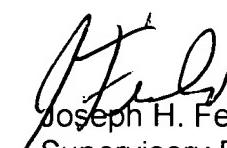


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